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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/689,959  | 10/21/2003  | Heinz Studer         | 33997.0091          | 4430             |
| 26712   | 7590        | 12/30/2004           | EXAMINER            |                  |
| HODGSON RUSS LLP<br>ONE M & T PLAZA<br>SUITE 2000<br>BUFFALO, NY 14203-2391 |             |                      | AMARI, ALESSANDRO V |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 2872                |                  |

DATE MAILED: 12/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/689,959

Applicant(s)

STUDER ET AL.

Examiner

Alessandro V. Amari

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2872



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/23/2004</u> . | 6) <input type="checkbox"/> Other: ____.  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 10, 13 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Stenzel EP 1205780.

In regard to claims 1, 10 and 13, Stenzel discloses (see Figure 1) a microscope or an assembly adapted to be held by a magazine of a microscope or a process for carrying out a selected investigation using a microscope comprising an optical path (5); a magazine (1) having a plurality of receiving areas (4); a plurality of assemblies (2), each of said plurality of assemblies being accommodated by a respective one of said plurality of receiving areas for selective positing in said optical path by operation of said magazine; a plurality of transponders (6) associated one with each of said plurality of assemblies, wherein each of said plurality of transponders includes stored data; and a reader unit (7) for reading said stored data of a transponder associated with an assembly positioned in said optical path and conducting said investigation in accordance with said read data as described in column 4, lines 54-58 and column 5, lines 1-11.

Regarding claims 2 and 15, Stenzel further discloses a writer unit for writing data into any one of said plurality of transponders as described in column 3, paragraph 0020.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stenzel EP 1205780.

Regarding claims 3 and 12, Stenzel teaches the invention as set forth above but does not teach that the plurality of assemblies includes a slide. Official Notice is taken that it is notoriously old and well known in the microscope art to include slides in positioning assemblies. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include slides in the microscope of Stenzel in order to provide for more convenient handling of specimens.

5. Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fay et al US 5,009,488 in view of Stenzel EP 1205780.

In regard to claims 1, 10, 13, 20 and 21, Fay et al discloses all of the limitations with the exception of the transponders and the reading unit. Specifically Fay et al discloses (see Figures 1, 3-5) a microscope or an assembly adapted to be held by a magazine of a microscope or a process for carrying out a selected investigation using a microscope comprising an optical path as shown in Figure 1; a magazine (52) having a plurality of receiving areas as shown in Figures 3 and 4; a plurality of assemblies (58), each of said plurality of assemblies being accommodated by a respective one of said

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plurality of receiving areas for selective positing in said optical path by operation of said magazine as shown in Figure 3, a plurality of markings (74) associated with one with each of said plurality of assemblies, a reader unit (76) for reading data from markings and conducting said investigation in accordance with said read data as described in column 3, lines 56-68 and column 4, lines 1-18. In regard to claims 20 and 21, Fay et al discloses (see Figures 1, 3-5 and 7) a computer executable process or computer readable storage medium storing computer executable instructions for performing steps of reading data associated with a filter (58) in an optical path of a microscope; reading filter data from a database, said filter data corresponding to a selected microscopy investigation; comparing said data with said filter data; and opening a shutter (77) in said optical path if said data provided match said filter data as described in column 4, lines 44-68 and column 5, lines 1-20.

However, in regard to claims 1, 10 and 13, Fay et al does not teach a plurality of transponders associated one with each of said plurality of assemblies, wherein each of said plurality of transponders includes stored data; and a reader unit for reading said stored data of a transponder associated with an assembly positioned in said optical path. Further, regarding claims 2 and 15, Fay et al does not further teach a writer unit for writing data into any one of said plurality of transponders. Further, in regard to claims 20 and 21, Fay et al does not teach reading data from a transponder associated with a filter.

In regard to claims 1, 10 and 13, Stenzel does teach (see Figure 1) a plurality of transponders (6) associated one with each of said plurality of assemblies, wherein each

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of said plurality of transponders includes stored data; and a reader unit (7) for reading said stored data of a transponder associated with an assembly positioned in said optical path as described in column 4, lines 54-58 and column 5, lines 1-11.

Regarding claims 2 and 15, Stenzel does teach a writer unit for writing data into any one of said plurality of transponders as described in column 2, lines 49-58 and column 3, lines 1-35.

In regard to claims 20 and 21, Stenzel does teach reading data from a transponder associated with a filter as described in as described in column 2, lines 49-58 and column 3, lines 1-35.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the transponders of Stenzel in the microscope of Fay et al in order to provide for input of additional information or rewriting of data on filters or assemblies making possible improved automatic identification of filters or assemblies and their position in the beam path of the microscope.

Regarding claims 4 and 11, Fay et al discloses that each of said plurality of assemblies includes a filter as described in column 3, lines 56-68 and column 4, lines 1-18.

Regarding claim 5, Fay et al further discloses a motor (62) connected to said magazine for moving said magazine as shown in Figure 7 and as described in column 3, lines 56-68 and column 4, lines 1-18.

Regarding claim 6, Fay et al discloses an electronic control unit (104, 106) for controlling processes as described in column 4, lines 63-68 and column 5, lines 1-20.

Regarding claims 7 and 17, Fay et al further discloses (see Figures 3-5) an electronically operated shutter (77) for selectively blocking said optical path as described in column 4, lines 63-68 and column 5, lines 1-20.

Regarding claims 8 and 16, Fay et al discloses that said microscope is designed for fluorescence measurements as described in column 2, lines 6-9.

Regarding claim 9, Fay et al discloses that said microscope is a stereomicroscope as described in column 3, lines 33-39.

Regarding claim 14, Fay et al further discloses the steps of reading reference data corresponding to said selected investigation, comparing said read data with said reference data and stopping said investigation if said read data does not match said reference data for said selected investigation as shown in Figure 8.

Regarding claim 18, Fay et al further discloses the step of storing said read data as shown in Figures 7 and 8 and as described in column 4, lines 63-68, column 5, lines 1-20 and column 6, lines 4-14.

Regarding claim 19, Fay et al further discloses the step of using said read data that have been stored to provide operational data as shown in Figure 8 and as described in column 4, lines 63-68, column 5, lines 1-20 and column 6, lines 4-14.

Regarding claims 3 and 12, Fay et al in view of Stenzel teaches the invention as set forth above but does not teach that the plurality of assemblies includes a slide. Official Notice is taken that it is notoriously old and well known in the microscope art to include slides in positioning assemblies. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include slides in the

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microscope of Fay et al in view of Stenzel in order to provide for more convenient handling of specimens.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alessandro V. Amari whose telephone number is (571) 272-2306. The examiner can normally be reached on Monday-Friday 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ava *ava*  
23 December 2004

  
**DREW A. DUNN**  
**SUPERVISORY PATENT EXAMINER**